

Notice of Allowability

Application No.

09/754,988

Examiner

Callie E. Shosho

Applicant(s)

PALUMBO ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 11/13/03.
2. ☒ The allowed claim(s) is/are 1,5-7,9-18,21-25,30-35,38 and 39.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | 7 <input type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

Callie E. Shosho
Primary Examiner
Art Unit: 1714

DETAILED ACTION

1. The present claims are allowable over the "closest" prior art Moffatt et al. '257 (U.S. 6,323,257), Ikeda et al. (U.S. 5,952,429), WO 99/31175, and Moffatt et al. '932 (U.S. 6,221,932) for the following reasons:

Moffatt et al. '257 disclose modified pigment, method for making the modified pigment, and ink comprising the modified pigment wherein the modified pigment comprises organic group comprising the reaction product of pigment having attached electrophilic group with nucleophilic polymer. However, there is no disclosure or suggestion in Moffatt et al. '257 that the resulting reaction product is then further reacted with acylating agent as required in all the present claims.

Ikeda et al. disclose modified pigment, method for making the modified pigment, and ink comprising the modified pigment wherein carbon black pigment with functional group is reacted with polymer that comprises nucleophilic reactive group wherein the resulting reaction product is then further reacted with acylating agent. However, there is no disclosure or suggestion that the functional group present on the polymer is an electrophilic group as required in all the present claims.

WO 99/31175 discloses modified pigment and method for making the modified pigment wherein the modified pigment comprises reacting carbon black pigment which has attached organic group which has attached ionic group with at least one polymer which attaches to the ionic group. However, there is no disclosure or suggestion in WO 99/31175 that the resulting reaction product is then further reacted with acylating agent as required in all the present claims.

Moffatt et al. '932 disclose modified pigment, method for making the modified pigment, and ink comprising the modified pigment wherein the modified pigment is obtained by reacting a pigment having an attached functional group with a nucleophilic polymer. However, there is no disclosure or suggestion in Moffatt et al. '932 that the resulting reaction product is then further reacted with acylating agent as required in all the present claims.

Thus, it is clear that Moffatt et al. '257, Ikeda et al., WO 99/31175, and Moffatt et al. '932, either alone or in combination, do not disclose or suggest the present invention.

In light of the above, it is clear that the rejections of record are untenable and so, the present claims are passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Callie Shosho

Callie E. Shosho
Primary Examiner
Art Unit 1714

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11/24/03